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IN THE

Supreme Court of the United States

OCTOBER TERM, 1941.

No. 323

MUNCIE GEAR WORKS, INC., ET AL.,

Petitioners,

vs.

JOHNSON BROTHERS ENGINEERING CORPORATION AND OUTBOARD, MARINE & MANUFACTURING COMPANY,

Respondents.

BRIEF FOR RESPONDENTS.

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Respondents.

BRIEF FOR RESPONDENTS.

This case relates to outboard motors, and insofar as any issues before this Court are concerned involves Johnson Patent No. 1,716,962 (R. 340) which was held valid and infringed by the Court of Appeals for the Seventh Circuit. Certiorari was granted on petition of Defendants-Appellees below.*

The issues here concern only validity and not infringement.

The District Court and the Court of Appeals both held that the patent had been infringed by Petitioners. The petition for writ of certiorari did not raise any infringement issue, nor is infringement denied in Petitioners' brief.

* Note: As Petitioner, Muncie Gear Works, Inc., was the manufacturer of the infringing outboard motors and is defending this suit, the term "petitioner" when used in the singular in this brief designates it.

OPINIONS OF LOWER COURTS.

Supplementing Petitioners' report of opinions in the present proceeding wherein the Circuit Court of Appeals for the Seventh Circuit sustained the Johnson patent in suit (119 F. (2) 404), this same patent and the claims here involved have been sustained in the Sixth Circuit by Judge Knight sitting in the District Court for the Eastern District of Michigan in *Johnson Brothers Engineering Corporation v. Caille*, 8 F. Supp. 198, where essentially the same prior art was before the Court. No appeal was taken from Judge Knight's decision.

STATEMENT OF THE CASE.

Petitioners' statement contained on pages 2 and 3 of its brief, while accurate so far as it goes, fails to present to the Court any outline of the facts sufficient to clarify the real issues.

As supplementary to Petitioners' statement of the case, we are therefore including a general outline of the place of the invention of the Johnson patent in suit in the high-speed, high-power, outboard motor art, as of assistance to the Court in the determination of the three issues presented by Petitioners in their argument directed to alleged invalidity, namely: (1) alleged delay in making the claims in issue; (2) alleged aggregation; and (3) alleged anticipation and lack of invention over the prior art.

GENERAL STATEMENT.

The patent here involved is of major importance, both because of its solution of vital problems which had theretofore stalled the industry, and also because of the fact that the structure of this patent has been widely adopted for certain high powered outboard motors which it is not possible to use efficiently without employing the invention of the patent. The patent has now been universally recognized by the industry with the exception of the Petitioners (R. 43).

The Respondent-plaintiff, Outboard, Marine & Manufacturing Co., maintains two separate plants for the manufacture of outboard motors. Its Evinrude Motors Division is located at Milwaukee, Wisconsin, and its Johnson Motors Division at Waukegan, Illinois. Each has its own separate engineering and production staff. It is licensee of

the patent in suit, which is owned by Johnson Brothers Engineering Corporation.

Respondents assert responsibility for most of the outboard motor developments in the industry (R. 616). In contrast, Petitioner has not shown any of its designs to have been based upon its own independent work. There can be no doubt on the record of this case that Petitioner has indulged in wholesale copying of the improvements which the Respondents have developed and patented (R. 623).

THE INVENTION IN CONTROVERSY.

The generalities of prior art outboard motor structure are succinctly described in the paragraph of Petitioners' brief at the bottom of page 4 and the top of page 5. There is not, however, in Petitioners' brief any statement of the nature of the present invention which is sufficiently definite to serve as a basis for discussion of the issues presented in this case.

The invention in controversy is directed to the problem of cavitation. At the middle of page 5, Petitioners' brief, Petitioners concede:

"Early in the development of the art 'cavitation' was recognized as an effect that it was desirable to overcome or eliminate."

Respondents welcome this admission inasmuch as the undisputed testimony shows that until the invention of the patent in suit, the problem of "cavitation" had not been solved.

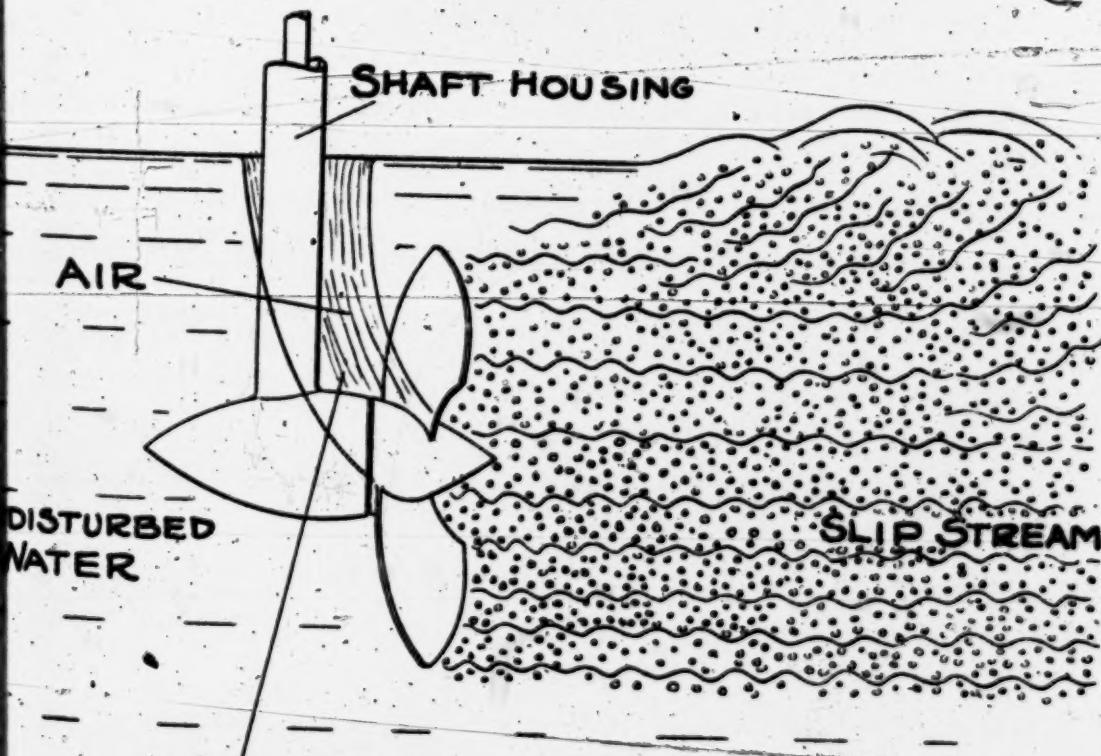
As will be explained in detail hereafter, cavitation is a phenomenon by which a propeller subject either to excessive power or to excessive load or to insufficient draft tends to draw air from the surface to replace the water forced rearwardly by the propeller slip stream so that the propeller operates partially in air instead of entirely in

water, thereby losing its propulsive grip upon the body of water in which it operates.

For lack of a solution, the industry was at a standstill so far as the development of high powered, high speed outboard motors was concerned. In the early 1920's, outboard motors were being used in races. High speed boat hulls were known. High powered engines were available. But high powered outboard motors could not be operated because of the phenomenon known as "cavitation" which no one prior to Johnson ever succeeded in solving (R. 43).

The following cut shows how cavitation is caused.

CAVITATION



CAVITATION

DIAGRAMMATIC ILLUSTRATION.

Propulsion of the boat depends upon reaction between the propeller and the water. If the propeller were 100% efficient, and its load negligible, the propeller would screw its way through the water without displacing the water.

In practice, water is displaced rearwardly in a so-called slip stream. The greater the resistance occasioned by the boat and the skin friction of the outboard motor itself, the greater will be the proportion of the power which, instead of being used for propulsion, tends to be lost in merely displacing water. If the boat is tied to the dock or the skin friction of the submerged parts of the motor is infinite so that the boat can not move, then the entire power of the engine is dissipated in displacing water.

If the propeller is to operate effectively the water displaced must be completely replaced by other water. In practice, the water displaced in the slip stream tends to be replaced, not by water, but by air drawn from the surface. This phenomenon is known as cavitation. It not only deprives the propeller of useful thrust but, since the propeller is now operating with lessened resistance, the engine tends to "run away," with the result that the engine may tear itself to pieces (R. 40 and 44). Thus, prior to the invention of the patent, cavitation limited the power of outboard motor engines. An increase in power would not correspondingly increase boat speed, but would merely increase cavitation and produce a dangerous situation.

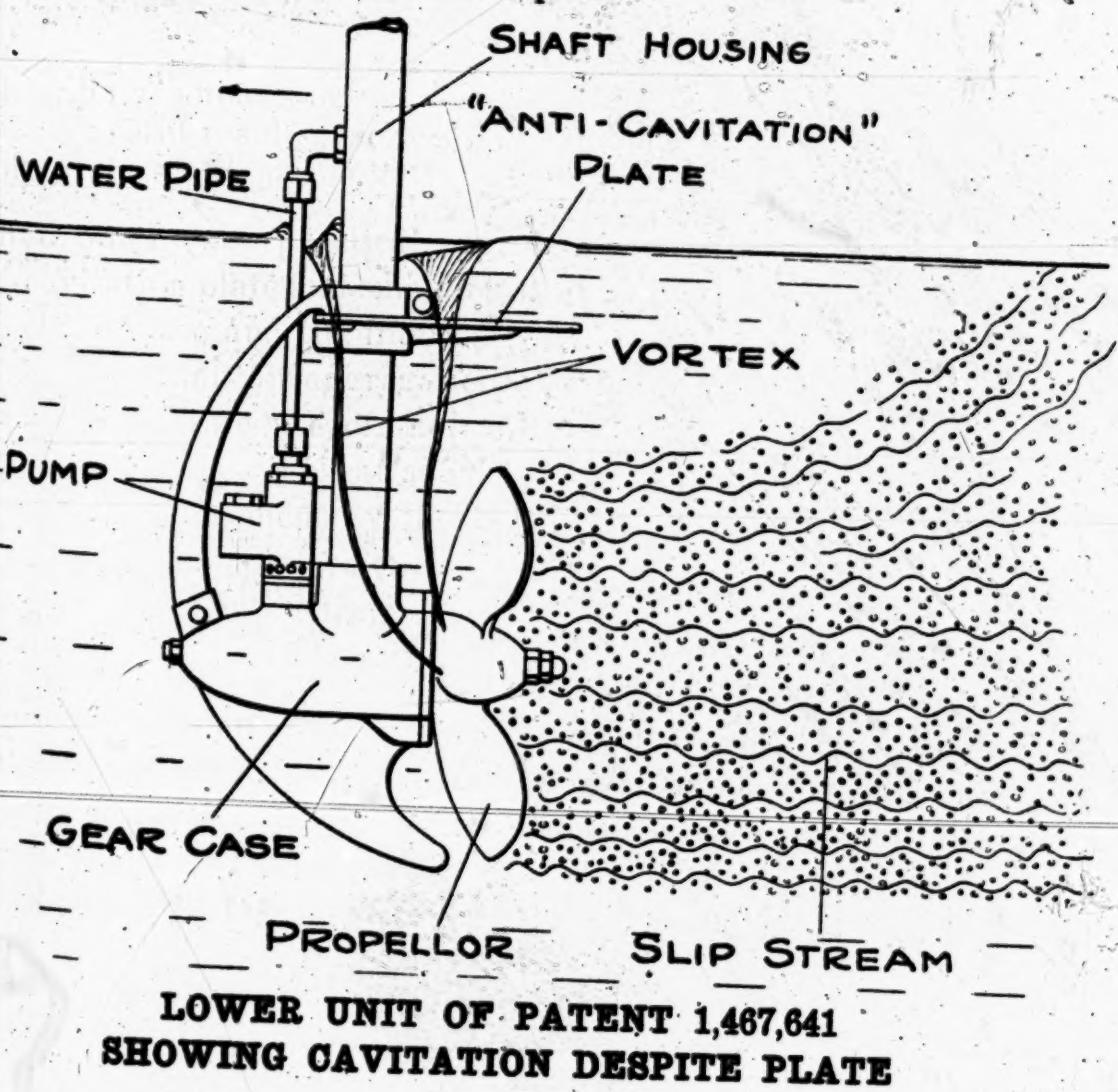
An approximately constant total engine power is divided between useful propulsion and wasteful slip stream, the proportion going to each being variable according to the balance between (1) resistance to propeller movement and (2) resistance to boat movement.

An increase in boat resistance or in the resistance of the submerged housing parts of the outboard motor, as by unnecessarily enlarging any submerged surface, will decrease propulsion and increase slip stream. Likewise, a decrease in propeller resistance, such as occurs when air reaches the propeller due to cavitation, will divert power otherwise available for propulsion.

Maximum propulsive efficiency requires, therefore, (1)

that resistance to boat movement (skin friction) be kept at a *minimum*, by reducing area of all submerged parts of the outboard motor and (2) that resistance to propeller rotation be kept at a *maximum* by preventing cavitation and keeping a body of water, unmixed with air, in the path of the propeller, so that the power of the motor will not be wasted by "racing" the propeller in a body of water mixed with air.

Petitioners assert (p. 5) that the use of an anti-cavitation plate cured this difficulty. This statement is not merely unsupported in the record; it is contrary to the fact. The following cut is diagrammatic, based on the testimony (R. 40-44, 203-205, 209, 214, 215, 225, 226) and shows, in the light of present day knowledge, why the problem of cavitation was not solved by the mere use of a so-called "anti-cavitation" plate.



While anti-cavitation plates made small, low-powered outboard motors more efficient, such plates alone were utterly ineffective to solve the problem of cavitation for high power, high speed motors, where admittedly the need for such solution was vital. Bearing in mind the foregoing analysis of the causes of cavitation, it must be obvious that those causes are greatly aggravated when any effort is made to add power and speed.

To get speed, skin friction must be reduced (R. 46). "For high propulsion efficiency the propeller should be as close to the surface as possible" (R. 49), but "If the propeller is too close to the surface it is bound to cavitate easier" (R. 41). Moreover "As the power is increased the tendency toward cavitation is also increased" (R. 40).

Thus, both the increased power and the shallow propeller setting necessary for increased speed are factors which increase cavitation. Why not, then, increase the size of the anti-cavitation plate? Especially since, "by using an anti-cavitation plate it is possible to move the propeller closer to the surface than it would be otherwise" (R. 42).

The answer is that there are practical limits to the size of plate that may be used. A plate too large will introduce so much skin friction as to increase resistance to propulsion and thereby upset the balance between power used in propulsion and that wasted in slip stream. By increasing resistance to boat movement the excessively large plate causes excessive water displacement in the slip stream and this *promotes* the cavitation which the plate was intended to cure. One may visualize this by imagining a plate of infinite resistance so that the entire engine power is used to displace water without moving the boat. Within practical dimensions some power would go for propulsion but so much would be lost that if cavitation be prevented by using a large plate, the drag of the plate would preclude

the possibility of getting the speed which would be the sole objective of the power increase (R. 46).

Such was the dilemma which confronted the art prior to Johnson. Even with a plate, it was impossible to get high speed because high speed took high power; high power increased tendency to cavitate, requiring a larger plate; but a larger plate introduced increased resistance (R. 46, 214, 215) and the increased resistance used up the increase in power without producing or permitting the desired increase in speed. While streamlining is old it is ineffective by itself in preventing cavitation, since if the propeller is up near the surface of the water (essential for high speed, R. 67, 68) the streamlining without an anti-cavitation plate still allows air from the surface to become mixed with the water, thus preventing high speed propulsion and causing the motor to "race" (R. 44).

What we have stated is supported by the following excerpts from the undisputed testimony. They tell in the words of the witnesses how Johnson solved the problem. They describe how a smooth walled housing, not confined merely to the zone of the propeller, but *extended above the plate and enclosing the water passages, performed an entirely new function, never previously performed by streamlining*, whereby the structure and functioning of the plate were modified. Through the co-operative action of the elements of the claims in suit, an anti-cavitation plate could be made *smaller even though the power was increased, and at the same time more effective*, so that the high speed commensurate with the increased power could be realized. The Court should remember that in these respects the witnesses are testifying regarding results wholly unknown until the Johnson invention.

Irgens testified:

Air being sucked into the propeller slip stream "hurts the efficiency of the propeller. It causes cavitation and the propeller loses its grip on the water.

• • • the motor will speed up and the propulsion effort of the motor is reduced. • • • if it cavitates too violently the motor can run away and actually break up. • • • as the power is increased the tendency toward cavitation is also increased" (R. 40).

To prevent or minimize cavitation "the plate has to be submerged and there should be a sheet of water overlying the plate and the plate thereby effectively seals any tendency for air being sucked down from the surface of the water, down into the propeller stream. • • • The housing 17 must be shaped in such a way that the water will move smoothly around the housing without having any eddy currents created. • • • If eddy currents are created then cavitation is very much more apt to result. When an eddy current is created it forms a vortex or hollow through which air can be sucked down into the propeller stream" (R. 40, 41).

That portion of the casing 17 which is above plate 20 has an effect on cavitation "because the water, after being split by the housing, must also close behind the housing in order to eliminate any possibility of creating a hollow behind the housing through which air might be sucked" (R. 41).

The advantage of locating water passages in the interior of such a housing is that "As water passages they would work just as well on the outside, but for streamline effect they would not. They would obstruct or hurt the streamline functioning of the housing". "At the present time I do not" (believe it would be possible to make a high speed high powered engine, water cooled, that would not have the construction of the patent, so far as the smooth walled housing, the anti-cavitation plate and the internal water passages are concerned) (R. 42, 43).

"They co-operate to increase the efficiency of the housing and reduce a tendency to cavitate.

If you assume that if that streamline was left off, either above or below the anti-cavitation plate, then the water lines and the drive shaft would be exposed and there would be much more of a tendency to cavi-

tate and the plate would have to be made larger * * * they do co-operate. * * * If the lines above and below the plate are smooth, then the plate can be smaller. * * * it reduces skin friction" (R. 214, 215). "The smaller the better, because surface friction is reduced" (Surface friction materially reduces speed). (R. 46).

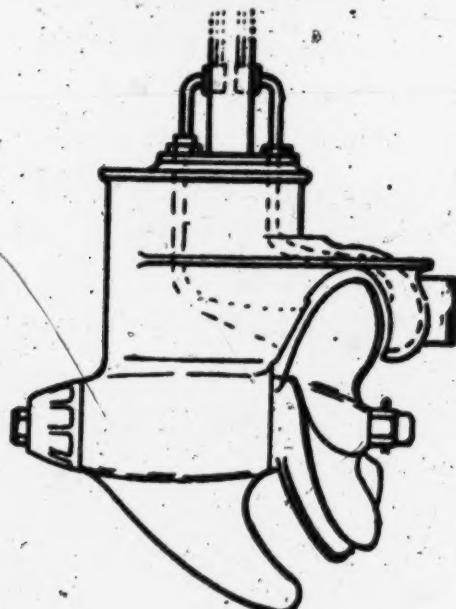
Tanner testified:

"Yes" (There is co-operation between the smooth walls of the housing and the anti-cavitation plate) * * * "If you have smooth walls but no anti-cavitation plate you can get cavitation. If you do not have the smooth walls and you do have an anti-cavitation plate, the plate must be very large in order to prevent cavitation. If you have the combination of smooth walls and an anti-cavitation plate, you can have a smaller plate and better over-all efficiency". "I cannot think of any" (large sized and high powered motors) "made today that does not have that combination" * * * "I don't believe it could" (be operated successfully without having smooth walls above and below an anti-cavitation plate and having the water passages inside) (R. 225, 226).

None of the foregoing was disputed in any respect.

The following is a reproduction of the lower unit of the patent in suit.

**LOWER UNIT OF
JOHNSON 1,716,962**



Note how the water passages, exposed, wherever used, in all prior art devices in which anti-cavitation plates have been usable, are enclosed above the anti-cavitation plate, as well as below, by a smooth walled housing in the Johnson construction. This permits a smooth flow of water over the plate, thereby making the plate effective even at high power and high speed to prevent cavitation which but for the smooth walled housing above the plate must have occurred.

Respondents desire to emphasize the fact that the smooth walled housing in the Johnson construction is used for an entirely new purpose. The only use of smooth walls or streamlining in the prior art was to minimize resistance to movement of the device through the water. Petitioners so admit on page 6 of their brief where they say:

... *** * it was early realized that it was desirable to shape the propeller casing so as to reduce or minimize its resistance to the water streaming past."

Petitioners, although copying the essentials of Johnson's invention and thus obtaining his highly advantageous result, apparently have not even yet grasped the fact that in the Johnson construction the smooth walls perform an additional function having little or no relation to the resistance to movement of the device through the water. It is true that in either case the smooth walls or streamlining eliminate eddies, but Johnson perceived and found a remedy for the previously unknown fact that eddies occurring *above* an anti-cavitation plate could nevertheless have an effect upon the problem of cavitation *below* the plate. The prior art inventors thought it sufficient to provide the plate and took no cognizance of what happened above the plate. Johnson provided smooth walls above the plate, thereby making the plate more effective and enabling the plate itself to be reduced in size and the power and speed of

the engine increased without any resulting cavitation. This was invention by any standard.

Since anti-cavitation plates alone did not make high powered, high speed motors possible, and since smooth walls or streamlining alone also failed to make high power and high speed possible, how was the art to know, without the inventive genius of Johnson, that the combination of the anti-cavitation plate with smooth walls both above and below the plate, enclosing the water passages necessary for cooling the engine, would, at one stroke, both solve the problem of anti-cavitation and at the same time make possible the use of high powered, high speed devices for which the art had been seeking?

The undeniable fact of record is that the art searched in vain for an answer to this problem. This is expressly admitted in Petitioners' brief (p. 5), where Petitioner concedes:

"Early in the development of the art, cavitation was recognized as an effect that it was desirable to overcome or eliminate."

It is most significant, in the face of this admission, that Petitioners cite no evidence whatever to show that the undesirable effect of "cavitation" was ever eliminated until the invention of the patent in suit.

Within a few years after the introduction on the market of the subject matter of this patent by Johnson Motor Co., licensee of the invention in controversy, many manufacturers were making outboard motors of increased power through the use of the Johnson invention. It is undisputed that the production of such motors was not possible until Johnson showed the way.

The undisputed testimony is that since Johnson made this invention, \$60,000,000 worth of outboard motors embodying the subject matter of this patent have been made (R. 227, 228, 250). The significant and noteworthy fact

is that the invention of the patent was a prerequisite to the production of these motors.

It is believed that it must be conceded that this patent has had a basic and fundamental effect on the industry and that it is an important patent by any test.

The presumption of validity attaching to this patent is reinforced not only by the decision of the Court of Appeals in the present case, but also by the decision of the District Court for the Eastern District of Michigan, sustaining its validity in the case of *Johnson Brothers Engineering Corp. v. Caille*, 8 F. Supp. 198.

The long and well reasoned opinion of Judge Knight holding validity is based upon the following well-established principle (p. 207):

"The test of patentability is whether the assembly of known elements in a new combination produces a new, practical, and beneficial result, and whether the combination so made results from the application of other than ordinary mechanical skill. The rule as stated is this-wise: It is perfectly well settled that a new combination of elements, old in themselves but which produce a new and useful result, entitles the inventor to the protection of a patent." Citing *General Fireproofing Co. v. Expanded Metal Co.*, 214 U. S. 366 and other cases.

It is significant that Judge Knight, in the aforesaid decision sustaining the validity of this patent, had before him the same typical prior art here relied upon by Petitioners.

SUMMARY OF ARGUMENT.

Delay in presenting in a pending application claims based upon its original disclosures does not invalidate such claims; particularly in the absence of intervening rights creating estoppel available to a defendant.

Hobbs v. Beach, 180 U. S. 383, 394, 395.

Crown Cork v. Gutmann, 304 U. S. 159, 167.

Esnault-Pelterie v. United States, 81 Ct. Clms. 785;

27 U. S. P. Q. 272, 284 (Affirmed by this Court after this issue was raised, 303 U. S. 26).

A structure in which known elements coact in a new combination productive of a new and useful result (or an old result in a more facile, economical and efficient way) is a patentable combination, and not an aggregation.

Loom v. Higgins, 105 U. S. 580, 591.

Hailes v. Van Wormer, 20 Wall. 353, 368.

Diamond Rubber Co. v. Consolidated Tire Co.,
220 U. S. 428, 443.

Expanded Metal Co. v. Bradford, 214 U. S. 366,
381.

Even if there were doubt as to validity, public policy requires that a patent be sustained rather than destroyed.

Grant v. Raymond, 31 U. S. 217, 240, 242.

Smith v. Snow, 294 U. S. 1, 14.

Eibel Process Co. v. Minnesota Paper Co., 261 U. S. 45, 55, 56.

Rubber Company v. Goodyear, 9 Wall. 788, 795.

Topliff v. Topliff, 145 U. S. 156, 164.

Turrill v. Railroad Co., 68 U. S. 491, 510.

Cantrell v. Wallick, 117 U. S. 689, 695.

Radio Corp. v. Radio Engineering, 293 U. S. 1, 7.

ARGUMENT.

Petitioners base their attack upon the validity of the Johnson patent on three points; namely,

- I. Alleged delay in introducing the claims at issue into the application for the patent in suit.
- II. Alleged aggregation of the claims at issue, and
- III. Alleged anticipation by or want of invention in such claims over the prior art.

This Court has repeatedly held that in a case before it on certiorari it will only consider the questions as to which the petition was granted (Rule 38 (2)). That the petition for certiorari was not granted in the instant case to review such usual questions as aggregation or validity over the prior art is obvious in view of the practice of this Court as stated in *Keller v. Adams-Campbell Co.*, 264 U. S. 314, 319, as follows:

*** * * Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent."

Since there has been no conflict of decision regarding the question of validity of the Johnson patent, but on the other hand its validity has been sustained in both the Seventh and Sixth Circuits, we assume that this Court did not grant certiorari merely to consider the commonplace defenses of alleged aggregation or lack of invention, which are defenses ordinarily advanced by every infringer in an attempt to justify his conduct. Nevertheless, as we shall next show, it appears that alleged aggregation is the only issue which is even properly brought before this Court.

Petitioners' first point (alleged invalidity by reason of

delay in presenting the claims) is a new issue neither pleaded nor presented at any time at the trial or in the Circuit Court of Appeals and based on wholly unfounded assertions of fact, as will hereinafter be shown. Petitioners' third point (the allegation that the claims are either anticipated by or lack invention over the prior art) was not mentioned in the petition for certiorari (note page 7) nor argued in any of the three points of Petitioners' brief (note pp. 13, 14 and 16) which accompanied the petition.

This leaves only the second point (aggregation), and on this point there is not only no conflict of decisions in different circuits, but four experienced judges in the Seventh and Sixth Circuits have considered the issue and agreed that the claims are not aggregative and are validly patentable over the art.

However, all the points raised in Petitioners' brief (in spite of the fact that we submit that the first and third are not even properly before this Court) will now be discussed in the same order as in that brief.

POINT I.

Mere delay in presenting claims based on the original disclosure of an application does not invalidate such claims, particularly in the absence of intervening rights creating estoppel available to a defendant.

Lest the Court have the idea that this is a case where the patent was long pending, it may be noted that *the patent in suit was granted well within three years of its filing date*. The filing date was August 25, 1926 and the issue date was June 11, 1929. The whole period of pendency was within the limits of recently proposed legislation under which three years was to have been allowed for normal prosecution.

In this case, delay in presenting the claims in issue does not represent any delay whatever in an effort to adequately claim the invention, for the same *parts* were included in originally filed claims such as claim 9 (claim 6 of the issued patent). The difference between claim 6,—allowed as filed,—and the claims in issue is a difference in phraseology and emphasis. That claim (Petitioners' Appendix p. 11) included the same primary elements as those of the claims in suit. It called for the propeller shaft casing, the propeller, and the anti-cavitation plate. While it did not mention the internal water passages specifically, it did refer to the member arching one side of the propeller, the principal function of which according to the original specification (Appendix p. 6; lines 2 to 7) was to provide water intake and discharge ports and ducts extending upwardly inside of the housing. No mention of any deflecting plate (19 of the patent drawing) was made in this claim.

There was no delay in attempting to claim the subject matter. Therefore, in discussing the delay in adopting the particular wording of the claims in issue, we do not concede that there was any delay in attempting to describe the essential features of the particular parts included in claims originally filed in the application.

Petitioners contend that the claims at issue, namely, claims 11, 12, 13 and 14 of the Johnson patent in suit, are invalid because they were not inserted in the application for more than two years after the application was filed, and more than two years after the subject matter had been commercially adopted.

The Johnson application when filed did contain claims more limited than was necessary in view of the broad nature of the invention disclosed in the application.

However, in an amendment of December 8, 1928 (Appendix p. 26), claims 20 to 25 were introduced

which likewise made no mention of the deflecting plate and thus were similar to original claim 9, but, as they did not include the arching members, were even more similar (substantially identical) in subject matter to the claims now in suit, these latter having been voluntarily substituted in March 1929 without any intervening rejection of claims 20 to 25. Virtual identity of the subject matter of claims 20 to 25 and the claims in suit is shown by the unusual circumstance that the Examiner consented that the amendment of March 30, 1929 (introducing the specific claims in suit) "take its place in order of examination as of the amendment filed December 5, 1928" (Petitioners' Appendix p. 38).

It is well recognized that an applicant during the course of prosecution of his application may modify his claims from time to time, so that when the patent is issued they may be commensurate with the invention. Broader claims may be presented after more limited ones have been cancelled. This Court, in *Smith v. Snow*, 294 U. S. 1, 16, well stated the law as follows:

"It is of no moment that in the course of the proceedings in the Patent Office the rejection of narrow claims was followed by the allowance of the broader Claim 1."

It so frequently happens that an original application contains statements of invention and claims not consistent with the scope of the invention, that the Rules of Practice of the Patent Office contain the following express provision:

"48. When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he shall file a supplemental oath to the effect that the subject matter of the proposed amendment was part of his invention. . . ."

In compliance with the foregoing rule and the established practice of the Patent Office thereunder, a supple-

mental affidavit was filed in the Johnson application supporting the claims which subsequently became those at issue of the Johnson patent (Appendix to Petitioners' brief, page 47). The filing of such supplemental oath, whether or not strictly necessary, is common practice.

It is not contended by Petitioners and cannot be so contended that Petitioners acquired any intervening right or were in any manner prejudiced by the alleged delay in introducing claims to the subject matter in controversy. Petitioners were not even in the outboard motor business at the time such claims were introduced. Petitioners are not even shown to have been in the outboard motor business when the patent in suit was issued in June 1929 (R. 107).

It is true that after Johnson Motor Company, licensee under the patent in suit, had popularized devices embodying the subject matter of the claims in suit, at least one competitor copied the combinations of the claims in suit from the Johnson motor before claims closely resembling those in suit were presented to the Patent Office in December 1928. This was done by Lockwood Ash Motor Company, then a competitor, but subsequently merged to constitute a predecessor of Respondent, Outboard, Marine & Manufacturing Company. It is *not* a fact, as alleged by Petitioner, that Lockwood Ash entered the field more than two years before Johnson presented claims to the subject matter here involved. Lockwood Ash first adopted this combination for the 1927 season (the model year commences in January or February, R. 225). Johnson was claiming the specific subject matter in December 1928 (Appendix pp. 26, 28-30), or well within two years.

Moreover, it is desired to emphasize the fact that when Johnson amended his claims he was not attempting to dominate any improvements which had been made by Lockwood Ash or anyone else. The testimony as to the exact Lockwood Ash construction is somewhat nebulous

due to the fact that the witnesses were not addressing themselves to this particular issue (which never was raised below). But it does appear that Lockwood Ash had no more than the exact combination to which the claims in suit are addressed and which had previously been embodied in the licensed Johnson motor from which Lockwood Ash had copied these features.

Suppose the applicant for the patent in suit had waited, as he had a right to do, until after Lockwood Ash had entered the field before he had even filed his application and suppose that, after seeing the Lockwood Ash construction he had incorporated in his application at the time of the preparation and original filing and within two years after public use of the invention, the exact claims subsequently allowed him and now in suit. The Petitioner could not then have asserted even a colorable objection based upon anything done by Lockwood Ash. What difference does it make that the application was on file *before*, instead of after, Lockwood Ash copied the elements of these claims? Lockwood Ash was not deceived, for all proceedings in the Patent Office were secret and Lockwood Ash did not know what Johnson was claiming. In fact Lockwood Ash should have assumed that a construction so new and valuable was being claimed in its broadest aspect. And certainly Petitioners, not even in the field at the time, have not been prejudiced.

There is a clear distinction between the present case in which the claims in issue were included while the application was still in the secret files of the Patent Office, and the ordinary case of intervening rights as against a reissue application or the belated introduction of claims into a divisional application for interference or otherwise, where the parent patent, or the competitive patent, has issued without the claims in controversy. In all reissue cases, due to the grant of the patent without the claims later asserted, there is an implied public dedication or relinquish-

ment of the subject matter of such claims. If a patentee so situated delays in the recapture of that which he has dedicated or relinquished by the publication of the patent, there is every reason for penalizing him rather than those who have relied upon the situation thus publicly created. Nothing of the sort occurred in this case. There was no dedication or relinquishment, real or apparent. At no time did Respondent take any position from which any member of the public could understand an intent to dedicate or relinquish the subject matter of the claims here asserted.

In those cases which involve delay in copying the claims of an issued competitive patent, there results an extension of the monopoly and the public, and particularly any competitive intervener, may thereby be prejudiced. There is nothing of that sort in the present case. There is no competitive patent which claims this subject matter,—no competitor even so much as asserted that it had made this invention or that it had contributed anything to it. Insofar as competitors intervened at all, the subject matter here involved was being claimed well within two years of the first intervention and the whole pendency of the application for patent in suit was less than three years from its filing date.

This case, therefore, is distinctively different from any case in which delay in prosecution has ever been held to work a forfeiture.

The patentee and his assignee were at all times operating strictly within the statutes, and this Court has repeatedly held that where a patentee prosecutes his application within the provisions of the statutes and the rules of the Patent Office, the validity of the resulting patent cannot be challenged. In *Chapman v. Wintroath*, 252 U. S. 126, 136, 137, 139, this Court said:

“There is no suggestion in the record that the original application of the Chapmans was not prosecuted strictly as required by the statutes and the rules of

the Patent Office and therefore, it is settled, their rights may not be denied or diminished on the ground that such delay may have been prejudicial to either public or private interests.

"A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural but of purely statutory right. Congress, instead of fixing seventeen, had the power to fix 30 years as the life of a patent. No court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they were unwise or prejudicial to the interests of the public. *United States v. American Bell Telephone Co., et al.*, 167 U. S. 224, 247."

"* * * we cannot doubt that upon the case disclosed in this record, the Chapmans were within their legal rights in filing their divisional application at any time within two years after the publication of the Wintroath patent, and therefore the judgment of the Court of Appeals must be Reversed."

Directly in point is the decision of this Court in affirming the decision of the Court of Claims in *Esnault-Pelterie v. United States*. The first decision of the Court of Claims is reported 81 Ct. Cls., 785 (27 U. S. P. Q., 272). The case was then remanded by this Court for specific findings, as reported 299 U. S. 201 (31 U. S. P. Q., 298).

After the findings of the Court of Claims had been amended (84 Ct. Cls. 625), the judgment of that Court, holding six claims of the patent in suit valid and infringed, was affirmed by this Court, 303 U. S. 26.

In the opinion of the Court of Claims, the Court states one of defendant's contentions as follows (27 U. S. P. Q., 284):

"Defendant contends that there has been an illegal expansion of the original invention into the monopoly as expressed by the present claims in suit. This is

based upon the argument that the plaintiff did not insert claims directed to the vertical stick control until 1913 although his application was filed in 1908, and during the intervening period the device had come into general use in the United States."

The Court of Claims, after referring

"to the long-recognized right of a patentee to claim subject-matter disclosed by him at any time so long as his application is not yet issued."

proceeded to overrule defendant's contention, the Court, in support of its position, quoting extensively from the decision of this Court in *Overland Company v. Packard Company*, 274 U. S. 417, 423.

While holding that the review in that case was limited to questions of law (and obviously defendant's above contention involved a question of law), this Court affirmed the decision of the Court of Claims, *United States v. Esnault-Pelterie*, 303 U. S. 26, 28, 32, after the point of alleged delay had been raised by defendant in its petition for certiorari.

The following quotation from *Hobbs v. Beach*, 180 U. S. 383, 395 is important in view of the fact that Respondent's amendments to the claims of the patent in suit were directed only to the subject matter which Johnson had invented and introduced on the market and which others had copied without any improvements of their own:

"* * * He also amended his first claim to fit this contingency, by omitting mention of the secondary plunger, and adding a fourth claim, in which he describes the plunger as 'formed with an elastic or yielding foot.'

"All this was prior to the invention of the Horton machine, which was first put into use in September, 1889. Of course, the amendment of May, 1886, could not have been made with reference to this device. It is true that, in November, 1890, after application had been made for the Horton patent, new specifications and claims were filed, in which the invention was stated much more in detail, and with much fuller and more accurate language than before. But there appears to

have been no attempt to expand the original claims for the purpose of including the Horton patent."

In the present case, as in *Hobbs v. Beach*, there was no attempt to expand claims to cover or dominate anything contributed to the art by others. The thing covered was concededly the original work of Johnson himself and commercialized by the licensee under the Johnson application. Insofar as others entered the field at all, they did so purely as copiers of the Johnson contribution.

The facts recited above demonstrate conclusively that the cases upon which Petitioners rely have no possible application to the present situation.

In every instance Petitioners' cases are those in which there was an attempt to claim *new matter*,—matter not in any way disclosed in the original application. In most of Petitioners' cases it was further expressly held by this Court that the matter was not only new matter but *inconsistent* with the original disclosures. Even under such circumstances the cases upon which Petitioners rely held that the claims to such new and inconsistent matter are objectionable only (or primarily) when the rights of others intervene.

No such fact situation exists here. Even Petitioners have nowhere contended that the subject matter of the claims in suit is "new matter". Petitioners admit that the drawings of the application for the patent in suit were never changed and they do not question that the claims here in issue read on such drawings. It is established and conventional practice to permit an amendment either of the drawings or the specification, one in accordance with the other. Rule 70 of the Patent Office reads as follows:

"In original applications all amendments of the drawings or specifications, and all additions thereto, must conform to at least one of them as it was at the time of the filing of the application. Matter not found

in either, involving a departure from the original invention, cannot be added to the application even though supported by a supplemental oath, and can be shown or claimed only in a separate application."

The entire subject matter of the claims here in suit was, therefore, disclosed in the original Johnson application. It was entirely permissible under established Patent Office practice, and pursuant to Rule 70 of the Patent Office, *supra*, for the specification to be amended to describe the functions and advantages of the structure which the drawings, from the beginning, had shown. It is immaterial whether Johnson's patent solicitor understood what he was driving at; it is even immaterial whether Johnson himself understood the full advantage of his disclosure.

• *N. Y. Scaffolding Co. v. Chain Belt Co.*, 254 U. S.

• 32, 37.

Potts v. Creager, 155 U. S. 597, 606.

Diamond v. Consolidated, 220 U. S. 428, 435, 436.

The significant thing is the fact that within two years of the first competitive use of the structure in controversy, which Johnson concededly contributed to the art, the Johnson application (continuously disclosing the combination recited in the claims in suit), had been amended to specifically claim the Johnson contribution without limitation to extraneous and unnecessary features. It is further significant, as above noted, that Johnson did not attempt to claim (nor does the record show that he did in fact dominate) any independent contribution made by anyone else. He simply claims an invention which had clearly been disclosed in his own application when the latter was filed.

PETITIONERS' FACT PREMISES CHALLENGED.

Before concluding discussion of this issue, assumed to be the principal point upon which this Court was willing to grant certiorari, it is necessary to challenge fact statements and conclusions on the part of the Petitioners which go to the merits of the case and constitute the very basis for Petitioners' appearance in this Court. It is proposed to demonstrate Petitioners' numerous departures from the record by showing:

1. Petitioners have erred in stating facts going to the merits of their petition.
2. Petitioners have erred in asserting that this issue was pleaded and presented in the lower courts.

1. *Petitioners' assertions regarding the alleged belated introduction of the claims in suit are contrary to the facts of record.*

The very essence of Petitioners' case lies in the statement on page 9 of its current brief that the claim of invention was changed on March 30, 1929, "thus for the first time claiming an invention other than the deflection plate or its arched support." Petitioners contend that this was more than two years after competitive devices were on the market. These contentions and others of like nature appearing throughout the petition are not only unsupported by the record but are directly contrary to the established facts.

It is perfectly true that the claims in suit in precisely their present phraseology were introduced March 30, 1929, but these claims did not represent any material change in the character of the protection which applicant had previously sought. Since this matter goes to the root of Petitioners' case we invite a direct comparison of Petitioners' statements with the facts established by the record.

In the following sections, Respondents will demonstrate the incorrectness of each of the four statements of fact premise upon which Petitioners base their case.

A.

Petitioners' first premise is the erroneous statement on page 7 of the brief, to the effect that the drawing of the application for the Johnson patent in suit showed nothing which was not standard or conventional other than the extension of the casing in the form of an arch with a curved plate extending rearwardly therefrom. The fact is that the drawing disclosed and still discloses the combination of the claims in suit. Even Petitioners do not assert this combination to have appeared in the prior art. The claims in suit are combination claims. It has been consistently recognized by all parties and by the courts below, that all of the individual elements were old but that the combinations recited in the claims were original with the patentee.

Petitioners have not shown and cannot show in the prior art any instance of a propulsion device having a smooth walled housing enclosing a drive shaft and an internal water passage, and provided intermediate its height with an anti-cavitation plate so that the smooth walled portion of the housing lies above as well as beneath the plate. This structure is new irrespective of whether the plate is cast or otherwise attached upon such a housing. The drawing, therefore, does show something that is new other than the arch 16, 18, and the deflecting plate 19. The provision of a smooth walled housing above an anti-cavitation plate and enclosing the water passages and propeller drive shaft at that point is broadly new and performs the new and unexpected function of permitting the area of the plate to be reduced, even while increasing its efficacy to prevent cavitation. Petitioners' statement, if correct at all, can only be interpreted to mean that aside from the arch and the deflecting plate no other single specific element was

new in itself. However, if Petitioners' statement be thus limited, it is not addressed to the combination claims which are in issue in this case. Petitioners are faced with the dilemma that the statement quoted and italicized in Petitioners' brief because of its supposed importance, is either contrary to fact or, if so interpreted as to be correct, is entirely irrelevant and not addressed to the claims which Petitioners have asked this Court to consider.

B.

On page 8 of Petitioners' brief, Petitioners make and italicize the flat statement that on March 30, 1929 "the sole invention of Johnson shown, described or claimed in the application consisted of the deflection plate and its arched support."

Respondent challenges this statement in its entirety.

Petitioners nowhere question that the claims in suit are directly readable upon the drawing. It is admitted by Petitioners that the drawing was never changed. It is not true, therefore, that the invention claimed was not shown. The drawing showed the very combination claimed.

But that is not all.

The file wrapper which is printed as an appendix to Petitioners' brief contains, on pages 26 to 36, an amendment filed in the Patent Office under date of December 8, 1928, wherein the patentee Johnson submitted six claims, namely claims 20 to 25, inclusive, not one of which is directly or indirectly limited in any respect to the deflection plate or its arched support. It is not true, therefore, that on March 30, 1929, the sole invention claimed was the deflection plate or its arched support. And it is significant that Petitioners' entire case based on alleged public use for more than two years depends on the 1929 date erroneously asserted, and falls with the demonstrated falsity of the premise.

In fact, it is apparent from an analysis of such claims as

claim 6, 7 and 8 of the patent (which are original claims 9, 10 and 11,—see Appendix, p. 11) that notwithstanding the fact that limitations to the arch or the deflecting plate were present, the subject matter was nevertheless the same general subject matter as that of the claims in suit. The claims in suit are broadened in some respects but narrowed in other respects as compared with these original claims which were allowed without change. Thus, from the date this application was filed Johnson was claiming *toward* the claims in suit, and it is significant that at the critical date of December 8, 1928 Johnson's concept of proper claims to make had progressed to the point where he was no longer limiting his claims to the deflection plate or the arched support, either separately or in combination.

The assertion in Petitioners' brief that this did not occur until 1929, is diametrically contrary to the facts shown of record by the file wrapper forming the appendix to Petitioners' brief.

C.

On page 9 of their brief, Petitioners allege that on March 30, 1929, Johnson "for the first time" claimed "an invention other than the deflection plate or its arched support." As shown above, this assertion is directly contrary to the fact that on December 8, 1928, the Patent Office received an amendment in which none of claims 20 to 25 was limited to the deflection plate or its arched support which Petitioners would seem to imply had been the sole features of invention of the claims up to March 30, 1929. Not only were claims 20 to 25 not limited either to the deflection plate or the arched support, but the subject matter of such claims closely resembles that of the claims in suit, as later allowed by the Official Examiner.

D.

In their third assignment of error Petitioners assert that the subject matter of the claims in suit was "injected into the application, by amendment, more than two years and seven months after the application was filed, and more than two years after said subject matter had been commercially adopted." This assertion is challenged in all respects.

It has already been shown that the subject matter of the claims in suit was not first introduced March 30, 1929, but was continuously present in the case from the date of its filing. Concededly, the original claims were limited additionally either to the deflection plate or to the arched support. But claims without these limitations had, contrary to Petitioners' assertions, been filed December 8, 1928.

The difference in date is critical because the record shows that the only manufacture of devices embodying the invention which had occurred more than two years prior to December 8, 1928 was licensed manufacture by Johnson Motor Company, predecessor of Respondent Outboard, Marine & Manufacturing Company, and in 1926, exclusive licensee of Respondent Johnson Brothers Engineering Corporation, owner of the application for the patent in suit.

It is desired to attach particular emphasis to the point that this is not a case where a patentee attempted to amend his application to cover something that had been invented by others. This is a case where Johnson was the undisputed inventor of the subject matter of his patent. The only concern which produced outboard motors in accordance with the invention of the patent in 1926 was the exclusive licensee under the application for the patent in suit.

With respect to Lockwood Ash Motor Company, Petitioners say that the witness Tanner was "testifying with

respect to outboard motors manufactured by Lockwood Ash Motor Company in 1926" (Petitioners' brief, page 15). The quoted testimony does not support this statement. Tanner specifically said that the motor made and marketed by Lockwood Ash in 1926 did *not* have the combination described in the claims in suit (R. 225). The witness testified that Lockwood Ash "put on an anti-cavitation plate in the fall of 1926 for the 1927 model year." Here again, bearing in mind that the particular point now in issue had never been raised in the trial court, it is perfectly evident that there is nothing in this testimony which can be relied upon to establish that such a motor was completed before the 8th of December, 1926, or in fact that such a motor was ever completed, tested, or produced, at any particular time. If it was not introduced before the 1927 model year, as indicated by the witness, then its use did *not* antedate by two years the introduction of claims in the Johnson application December 8, 1928.

The model year commences in January or February (R. 225). Petitioners' incorrect assertion, contrary to the facts shown by the file history, that the patentee was exclusively claiming the deflection plate or arched support until March, 1929, is utterly without any possible significance in view of the facts established by the record. March, 1929, would be more than two years after the opening of the 1927 model year; but the actual date in December, 1928 when the patentee claimed the specific invention in controversy, without regard to deflection plate or arched support, was well within two years of the first competitive use of the invention, even assuming that the two year period is of any significance in the present case.

With respect to Evinrude and Elto, the witness makes it clear that he does not know the exact date but doubts that either concern put on the plate the same year as Lockwood Ash, so far as the witness could recall (R. 225).

Petitioners are in no position to complain or to try to

take advantage of the dearth of testimony on this point. The fault, if fault there be, is entirely theirs since the issue was neither pleaded nor raised below, nor did petitioners in any manner attempt during the trial to bring out facts bearing on this issue, the testimony of the witnesses being directed to entirely different points.

Further, the issue raised is one which must be pleaded to be taken advantage of. *Sachs v. Hartford Electric*, 47 F. (2d) 743, 748, (certiorari denied, 283 U. S. 854).

Reference to the record completely disposes of Petitioners' contention that adoption by the industry preceded by more than two years the first presentation of claims not limited to the deflecting plate or arched support. In the first place, even the original claims, limited as they were to the deflecting plate or arched support, were nevertheless aiming at the same general subject matter as the claims in suit. In the second place, even if the presence of limitations to the deflecting plate or arched support be regarded as limiting the claimed subject matter to a different invention, nevertheless it has been shown that Petitioners' assertions are incorrect as to the date when claims omitting such elements were first introduced, such claims having been incorporated December 8, 1928 instead of March 30, 1929. And finally, it has been conclusively shown that whatever might have been said for the 1929 date, it is not a fact that the record establishes any competitive use to have occurred more than two years prior to the 1928 date when claims of substantially the same scope as those in suit were actually introduced.

The case of *Crown Cork & Seal Co. v. Ferdinand Gutmann Co.*, 304 U. S. 159, is highly important on this issue, since this Court expressly held that in the absence of intervening rights it was not even necessary to excuse a lapse of *more* than two years in presenting a divisional application. The Crown Cork & Seal case presented facts much more unfavorable to the patentee than those here involved,

since the opinion of this Court (p. 164) showed that the Warth parent patent had been granted January 6, 1931, disclosing but failing to claim the preheating invention later asserted. The invention there in controversy was first claimed April 4, 1933, more than two years following the issue of the parent patent and approximately one year following the grant of a patent to a competitor on the preheating method. This Court (p. 165) pointed out that not only was alleged abandonment of the invention not pleaded, and thus not available as a defense, but the continuity of disclosure showed that "Warth intended to retain, not to abandon, the disclosed invention."

It is noteworthy that in the present case there is nothing which can be regarded as a dedication, express or implied, of the invention here in controversy. In all the cases where this Court has applied the two year limitation by analogy there has, in every instance, been some form of dedication to the public, followed by intervening rights for the two year period before the invention was asserted.

Thus, in *Webster Electric v. Splitdorf*, 264 U. S. 463, Kane made application February 2, 1910, and his parent patent 1,204,573 issued November 14, 1916. A competitive patent had issued to Podlesak March 4, 1913 and it was not until June 17, 1918 that there were introduced into the Kane divisional application claims intended to dominate the independent invention of Podlesak. This Court pointed out that five years had elapsed from the date of the competitive Podlesak patent disclosing the subject matter and three years had elapsed after the parties were actually in litigation based on the original patents. This was a clean cut case involving an attempt to recapture, more than two years after intervention by others, subject matter which had been expressly dedicated through failure to claim in the patents granted to both of the parties.

Similarly, in the reissue cases such as *Wollensak v. Reiher*, 115 U. S. 96, there is, in every instance, a dedica-

tion implied in the fact that the original patent has been issued without claims to the invention later sought to be recaptured. Even in such cases this Court has held first, that by dedication of the invention the public is presumed to have acquired intervening rights if the broader claims are not asserted within two years after the intervening rights have accrued; and secondly, that even where public or private intervening rights are presumed or shown, the lapse of two years will not be a bar if "the delay is accounted for and excused by special circumstances which show it to have been not unreasonable."

One vice of Petitioners' attempt to raise this issue in the present Court for the first time (apart from the fact that this Court is being asked to assume original jurisdiction on this issue unguided by any decision below on the point) lies in the fact that Respondents would be deprived of an opportunity to offer proofs pertinent to such an issue.

THE ISSUE OF INVALIDITY BY REASON OF ALLEGED BELATED INTRODUCTION OF CLAIMS WAS NEVER PLEADED NOR IN ANY MANNER PRESENTED BELOW.

Respondent can see no possible excuse for presenting for the first time in this Court an issue never considered below.

General Utilities v. Hilvering, 296 U. S. 200, 206.

Arkansas v. Stokes, (C. C. A. 8) 2 F. (2d) 511, 515.

U. S. National Bank v. First National Bank, (C. C. A. 8) 64 Fed. 985, 992.

Renwick v. U. S., (C. C. A. 7) 87 F. (2d) 123, 124.

Respondents raised this point in response to the petition for certiorari, but it is believed that this Court was misled by the nature of Petitioners' reply, wherein Petitioners gave a specific page reference to a brief not then before the Court, and stated that in that brief this issue had been

presented to the Court of Appeals. Respondents have now caused the Court of Appeals to certify to this Court the Petitioners' briefs in the Court of Appeals inasmuch as these documents clearly and completely contradict Petitioners' assertions. The question raised lies at the threshold of the entire controversy since the issue is not one in which any statute imposes a bar, and the bar which Petitioners seek to invoke involves an issue upon which Respondents are entitled to a day in court. They have never had an opportunity to present evidence or to be heard on this point for the reason that it was never pleaded nor in any manner raised in the lower courts.

Briefly, it is Petitioners' contention here that the claims in suit are invalid because (to quote Petitioners' point 1, page 14) "of the illegal assertion thereof (and of the subject matter to which they are directed) into the application for patent more than two years and seven months after the application was filed, and more than two years after such subject matter had been commercially adopted."

Was any such issue pleaded?

Petitioners rely upon a so-called "fourth defense" (R. 18) but reference to the two answers filed in these consolidated causes will show that the so-called "fourth defense" was an attempted "catch-all" paragraph asserted in identical language against all eight of the patents originally involved and containing an allegation that the patents were invalid on the ground "that the said applications were unlawfully enlarged during the prosecution thereof."

Nowhere in this pleading did Petitioners raise the specific and highly technical defense here asserted with reference to alleged "belated introduction" of claims more than two years after the intervention of public or private rights. Not only was no such point pleaded, but no such point was ever raised in the lower courts.

Petitioners have seen fit to raise an issue of veracity on this point. Petitioners' reply on petition for certiorari, page 3, asserted that the facts *belied* Respondents' contentions. Petitioners stated that the issue had been "presented and argued at length to the District Court, and to the Court of Appeals below in Petitioners' brief before the latter court, beginning at page 23 thereof."

At the time Petitioners' reply was placed on file and the petition for certiorari herein was granted, this Court had no means of ascertaining whether the portion of the brief so specifically and plausibly designated by Petitioners did or did not raise this issue. Reference to page 23 of Petitioners' brief in the Court of Appeals, which has now been brought before this Court, will show that on that page Petitioners were commencing the discussion of the subject of *anticipation* under the topical heading "Patent No. 1,716,962 is anticipated." The discussion continues through pages 23 to 28 and part of 29, and the only reference throughout this section to alleged belated introduction of claims is in connection with Petitioners' contention that the belated introduction of the claims shows that the subject matter was not then regarded as having the importance here ascribed to it. Said Petitioners (under the heading of "anticipation," p. 23):

"In considering these claims it is appropriate to first have in mind their historical background, in view of the importance that Plaintiffs place upon them as being for subject matter that 'solved a problem' previously 'stalling' a great industry. In the first place, the subject matter of these claims was in no way considered in or made a part of the original application *** It was not until more than two years later that the patentee on December 6, 1928, by his amendment 'C', added claims to his application covering any of the matter that is now deemed to be of such great importance."

Nowhere in this entire brief did Petitioners assert that

the claims now in issue were void by reason of alleged belated introduction. Nowhere in this brief did Petitioners assert that there were any intervening rights of any nature. The point was not raised in any form.

Moreover, prior to the petition for certiorari in this case, Petitioners filed in the Seventh Circuit Court of Appeals a "Petition for clarification and rehearing."

The petition for rehearing was directed entirely to questions of aggregation and lack of invention and at no time, not even in the petition for rehearing, was the issue here tendered ever presented to the courts below.

In *Webster Electric Co. v. Splitdorf*, 264 U. S. 463, 471, this Court pointed out that even under circumstances not existing in the present case delay in excess of two years may be overcome where it "is accounted for and excused by special circumstances, which show it to have been not unreasonable."

By failing to raise the issue below, Petitioners seek to deprive Respondents of an opportunity to meet the issue.

In the present case Petitioners' delay in raising this issue is as great as the period of delay which Petitioners seek to charge against Respondent in presenting the claims in suit and is much more serious in its effect. At the time of Respondent's alleged delay in presenting claims, Petitioners were not making motors of the type here involved, and consequently, were not in any manner prejudiced by anything that may have occurred. But Petitioners, by waiting until this case was in this Court before raising this issue, threaten the most severe prejudice to Respondents by depriving Respondents of an opportunity to "account for or excuse by special circumstances" such delay as may be proved to have occurred.

It is respectfully submitted that the evidence conclusively establishes that the issue here tendered was neither pleaded nor presented below. Should this Court consider such an

issue in the absence of a full hearing below? A hearing here on the issue tendered by Petitioners would deprive Respondents of their day in court. It is submitted that the writ of certiorari was improvidently granted upon the basis of erroneous statements of fact in the petition and Petitioners' reply. The petition should, therefore, be dismissed. *Keller v. Adams-Campbell*, 264 U. S. 314, 319.

POINT II.

The claims in suit are directed to patentable combinations and not to aggregations in view of record evidence establishing cooperation between elements.

It is noteworthy that Petitioners in discussing the issue of aggregation evade argument of this question and do not address themselves to the facts as shown by the evidence. Critical scrutiny by this Court of Petitioners' brief on this issue is invited.

The question as to whether there is or is not co-operation between the parts of a patented structure is a question of fact. As stated by the Court of Appeals (R. 622):

"The defense of aggregation falls in the face of what is established by testimony, and confirmed by our study of the operation of water propulsion devices in outboard motors." (Emphasis ours.)

In the present case Respondents will refer to the record to confirm by undisputed and irrefutable testimony of the witnesses the holding of the Court of Appeals that there is in fact cooperation between the parts which comprise the patented combination.

Petitioners' ingenious attempt to side-step this issue by phrasing questions and reiterating generalities without reference to the evidence in the case cannot stand against the facts of record.

The uncontested testimony of Respondents' expert witnesses is that there is a definite cooperation between the anti-cavitation plate and the smooth walls of the housing above and below the plate. The defense of aggregation fails unless the elements of a claim merely perform the same individual functions which they had previously performed in other structures and do not modify the functions of each other. If elements separately old in the prior structures when brought into cooperative relation in a patented structure accomplish a result more than the results separately accomplished by the elements in prior structures, they constitute a combination, and not an aggregation.

On the issue as to whether there is cooperation between the smooth walls of the housing and the anti-cavitation plate in the operation of the motor, we have reduced to narrative form a portion of the testimony of Mr. Tanner (R. 225 and 226) as follows:

I cannot think of any large sized high powered outboard motor made today that does not have that combination of an anti-cavitation plate and a streamlined housing. I believe that the Petitioners' 9 h.p. and 16 h.p. outboard motor could not be successfully operated without having smooth walls above and below an anti-cavitation plate and having the water passages inside. There is cooperation between the smooth walls of the housing and the anti-cavitation plate. If you have smooth walls but no anti-cavitation plate you can get cavitation. If you do not have smooth walls and you do have an anti-cavitation plate, the plate must be very large in order to prevent cavitation. If you have the combination of smooth walls and an anti-cavitation plate you can have a smaller plate and better overall efficiency involving the combination of less resistance to passage through the water and best possibility to prevent cavitation. For the successful operation of an anti-cavitation plate there should be an uninterrupted stream of water over the plate.

We have similarly reduced to narrative form a portion of the testimony of Mr. Irgens, the engineer of Respondent, Outboard, Marine & Manufacturing Co. at its Evinrude Division (R. 41, 44):

As the power is increased the tendency toward cavitation is also increased. The anti-cavitation plate has to be submerged and there should be a sheet of water overlying the plate. The plate thereby effectively seals any tendency for air being sucked down from the surface of the water into the propeller stream. The form of the housing has this relation to the problem of cavitation,—It must be shaped in such a way that the water will move smoothly around the housing without creating eddy currents. If eddy currents are created then cavitation is much more apt to result. When an eddy current is created it forms a vortex or hollow through which air can be sucked down into the propeller stream. The portion of the casing above the plate has an effect on cavitation. The water, after being split by the housing must also close behind the housing in order to eliminate any possibility of creating a hollow behind the housing through which air might be sucked. If the water failed to close properly behind the housing it would have a bearing on the ability of the anti-cavitation plate to resist these eddy currents. By using an anti-cavitation plate it is possible to move the propeller closer to the surface than would be otherwise. It would not be possible to make a high speed, high powered engine, water cooled, that would not have the construction of the patent, so far as the smooth walled housing, the anti-cavitation plate, and the internal water passages are concerned. From 1926 on, practically all of them have been made that way. When it is running at high speed it is absolutely essential to have a streamline construction and have means to prevent cavitation. Lacking such means it will cavitate and be absolutely unsafe. I regard the smooth walled housing and the anti-cavitation plate as being both necessary to prevent cavitation.

With respect to the significance of internal water passages in the combination, Mr. Irgens said (R. 42, 43):

"As water passages they would work just as well on the outside, but for streamline effect they would not. They would obstruct or hurt the streamline functioning of the housing. * * * All the big motors have internal water passages within the streamline contours."

* * * In my opinion it would not be possible to make a high speed, high powered engine, water cooled, that would not have the construction of the patent, so far as the smooth walled housing, the anti-cavitation plate and the internal water passages are concerned.

The testimony is undisputed that there is a cooperative relationship between the anti-cavitation plate and the internal water passages and the smooth walls or streamlining of that portion of the outboard motor structure which might produce eddies and vortexes in the vicinity of the plate. Mr. Irgens said (R. 214):

"They cooperate to increase the efficiency of the housing and reduce a tendency to cavitate. * * * If you assume that streamline was left off, either above or below the anti-cavitation plate, then the water lines and the drive shaft would be exposed and there would be much more of a tendency to cavitate and the plate would have to be made larger."

Referring specifically to Defendants' (Petitioners') motors, Plaintiffs' exhibits 17 and 18, the witness testified (R. 215) that it is a fact as to those motors that the streamlining or smooth walls of the housing above and below the anti-cavitation plate, with the water passages enclosed therein, are cooperative features to avoid cavitation. He continued:

"If the lines above and below the anti-cavitation plate are smooth, then the plate can be smaller. * * * It reduces skin friction."

Mr. Tanner said (R. 226) that there is cooperation between the smooth walls of the housing and the anti-cavitation plate. He explained:

"If you have smooth walls but no anti-cavitation

plate, you can get cavitation. If you do not have the smooth walls and you do have an anti-cavitation plate, the plate must be very large in order to prevent cavitation. If you have the combination of smooth walls and an anti-cavitation plate, you can have a smaller plate and better overall efficiency."

Petitioners have not pointed out, and there does not exist in the art, any such combination as that described in this testimony and comprehended within the claims in suit. Never previously in the art had smooth walls or streamlining been used with an anti-cavitation plate and disposed both above and below the plate so that the water disturbed by the passage of the outboard motor could close again over the plate in a solid stream to assist the plate in preventing cavitation without requiring the plate to be so large that all of the advantages of high power would be lost by the excessive skin friction of the oversized plate. To achieve this result the water passage required for the cooling of the engine had to be located inside of the housing, as otherwise the walls of the housing would not be smooth and the objective of the invention would be defeated.

Such is the evidence in the case; there is no evidence to the contrary. This Court will now appreciate why Petitioners' brief so glibly passes without argument the question of aggregation and why courts in the Sixth and Seventh Circuits have agreed that the established cooperation between the elements of the claim eliminates the defense of aggregation.

This Court's decision in *Powers-Kennedy Contracting Corp. v. Concrete Mixing & Conveying Co.*, 282 U. S. 175, 186, cited on page 18 of petitioners' brief in support of the argument that the Johnson claims at issue are invalid as covering mere aggregations of elements, does not support Petitioners' contention but clearly states the law, namely, that a claim comprising "old elements or devices accom-

plishing no more than an aggregate of old results" is not a patentable combination but an unpatentable aggregation.

There are many decisions of this Court holding that a claim covering a combination of elements is not invalid on the ground of aggregation when the elements cooperate to produce a combined result different from the separate results of the elements.

Hailes v. Van Wormer, 20 Wall. 353, 365.

Reckendorfer v. Faber, 92 U. S. 347, 357.

Palmer v. Corning, 156 U. S. 342, 344.

In the last cited decision, this Court well stated the law as follows:

"If a combination of unpatentable elements, as such, produces new and useful results, there can be no doubt that the combination is patentable."

As clearly pointed out by the practical experts of Respondents, the anti-cavitation plate and smooth walled housing above and below the plate and the internal water passages do accomplish more than an aggregation of the old results attained by the separate use of the said two elements. It is established that the result attained is a wholly new result incapable of achievement by the streamlining alone or by the anti-cavitation plate alone, or by the internal water passages alone, but depends for its accomplishment upon the cooperative relation of all of these features which, in the Johnson invention, were brought together for the first time to produce a new result and to make possible sizes and speeds of outboard motors which had theretofore been regarded as impossible despite the admission of Petitioners' brief that the art had long recognized the desirability of eliminating cavitation.

Counsel for Petitioners also rely on the decision of this Court in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545. A correct understanding of that decision clearly shows that it is not pertinent. It does not in any

way negative or limit the proposition that a new combination, even though it is made up of elements individually old, is inventive when the elements cooperate in a new manner to produce a new result. In this case the smooth walls or "streamline" perform a new function in cooperating to minimize cavitation.

In the *Lincoln Engineering* case, the patent merely covered an old combination in which the patentee had substituted a new element for one of the old elements, the new element performing only the same function in the old combination as did the element which it replaced. This Court said:

"* * * The invention, if any, lies in the improvement in the coupling device alone" (p. 551).

"* * * And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination" (p. 549).

No such situation exists as to the patent in the case at bar. The patentable novelty of the claims at issue is not predicated upon new elements in an old combination, but primarily upon new combinations of old elements.

POINT III.

The claims at issue are inventive over the entire art.

In the reasons relied upon for the grant of the petition for certiorari the issues of anticipation or lack of invention over the prior art were not mentioned (note p. 7). The Court of Appeals expressly denied anticipation (R. 621) and expressly found that the subject matter of the claims was inventive (R. 621, 622).

Judge Knight, in the District Court in the Sixth Circuit,

had previously found invention over substantially the same art in *Johnson Brothers Engineering Corp. v. Caille*, 8 F. Supp. 198. Petitioners are under a very heavy burden in arguing in their current brief a question which has been decided adversely to Petitioners' contention in both the Seventh and Sixth Circuits.

Petitioners' entire argument with respect to alleged anticipation and lack of invention falls in the face of the evidence which shows:

a. That the art had long recognized the problem, but without finding a solution (this is admitted by Petitioners themselves on page 5 of their current brief, where they say: "Early in the development of the art 'cavitation' was recognized as an effect that it was desirable to overcome or eliminate").

b. Knowledge in the art of the devices of the reference patents (all of which Petitioners concede to have been well known) did not lead to a solution of the problem which Petitioners concede the entire art was trying to solve.

c. The novel and cooperative relationship between the anti-cavitation plate, the smooth walls of the housing both above and below the plate, and the internal water passages is by no means an obvious one and, in the light of the history of record, clearly required invention for its conception.

This case comes within the ruling made by this Court in *Hildreth v. Mastoras*, 257 U. S. 27, 34, 35, where this Court said:

"The history of the art shows that Dickinson took the important but long delayed and therefore not obvious step from the pulling of candy by two hands guided by a human mind and will to the performance of the same function by machine. The ultimate effect of this step with the mechanical or patentable improvements of his device was to make candy pulling more sanitary, to reduce its cost to one-tenth of what it

had been before him, and to enlarge the field of the art. He was, therefore, a pioneer."

Petitioners rely primarily upon the patent to Smith (R. 418), which merely shows an anti-cavitation plate on an outboard motor which has no streamline or smooth surfaced housing with internal water passages, and the French patent to Echard (R. 591), which shows streamlining but no plate of any description, the streamlining terminating at the level of the top of the propeller and hence below the normal water level and below a level where it could cooperate to provide a smooth unbroken stream of water over a plate if a plate were added.

Not only does Echard fail to disclose or suggest any combination with streamlining of an anti-cavitation plate; but it will be noted that Echard did not even have the problem of cavitation in mind, since he shows a rib spanning the propeller to carry the rudder. This rib is not only unstreamlined but is downwardly inclined and calculated to create a vortex of its own when moved rapidly through the water. Moreover, immediately above the level of the propeller (and consequently necessarily below water level), there is a pump casing shown in detail in section in Fig. 2 which projects from the otherwise streamlined casting, and instead of being enclosed is fully exposed at a point where cavitation consequent upon its rapid movement through the water, is inevitable. Above this pump casing runs a hose, likewise adapted to produce cavitation. This hose or water pipe and the adjacent shaft housing together must, in the light of the established facts of record, inevitably produce serious cavitation such that even if an anti-cavitation plate were applied to this device, it still would not make the use of high power possible. On the comparable device shown in the drawings of the early Johnson Patent No. 1,467,641 (R. 482) and actually merchandised by Johnson Motor Company prior to the production of the device of the patent in suit, cavitation did

occur, notwithstanding the plate (R. 43, 44, 226). The testimony is that in order to prevent cavitation the structure must be smooth walled and the water passages must be inside, above, as well as below, the point where the anti-cavitation plate must be located, immediately above the propeller.

Elsewhere Petitioners have also made some reference, more or less casually, to the device of the old Evinrude patent No. 1,524,857 (R. 502). This device also failed to make possible the use of high power without cavitation. It is not of the same type as the outboard motor involved in the patent in suit because the lower unit of Evinrude is stationary and does not turn for steering. Consequently Evinrude found it necessary, particularly at the low power he was obliged to use, to have a big rudder (shown at 37 in the drawings) and this rudder occupied the very space in which a cavitation plate would have to be located if used. The necessity of the rudder in the structure of this patent precludes the possibility of applying an anti-cavitation plate to this device.

The patent to Pierce (R. 526) is also relied upon by Petitioners as showing a lower housing having a stream-line cross section. This patent is not a proper reference. In the first place, it does not show an anti-cavitation plate nor is it concerned with the problem of cavitation. In the second place, the patentee Johnson carried his invention back of the Pierce filing date by evidence which the Patent Office accepted as disposing of Pierce as a reference and which has been independently proved in the present case (cf. affidavits, Appendix 54, 55, 56 and accompanying drawings with testimony, Irgens R. 205, 207, Plaintiffs' exhibit 19, and Louis Johnson testimony R. 219, 220; H. L. Johnson testimony R. 232, 234).

Although the decision of the Patent Office will not be reversed unless clearly erroneous (*Morgan v. Daniels*, 153 U. S. 120), the evidence in this case establishing priority

of inventorship of Johnson over Pierce is even stronger than that before the Patent Office, as it consists of the testimony in open court of Irgens (R. 205), H. L. Johnson (R. 232), and L. J. Johnson (R. 210), and early drawings illustrating the Johnson invention at issue, Exhibit 19.

Doubt as to presence of invention should be resolved in favor of the patent, especially when invention has gone into extensive commercial use.

It is submitted on behalf of Respondents that there can be no reasonable doubt that Johnson made a patentable invention.

Any attempt on the part of Petitioners to make a contrary showing that invalidity is so clear as to be without doubt is absurd in view of the following considerations:

1. Judge Knight, in the Sixth Circuit (*Johnson v. Caille*, 8 F. Supp. 198) and Judges Evans, Trainer and Briggle, of the Seventh Circuit Court of Appeals, have held the Johnson patent valid. The Court of Appeals for the Seventh Circuit has during the past five years rendered more decisions in patent cases than any of the Courts of Appeal in any other circuits with the exception of the Second. This Court has often recognized the diligence with which the Seventh Circuit Court of Appeals has refused to sustain patents which it regarded as lacking in invention. A recent case in point is the *Automatic Devices Corp. v. Sinko Tool & Mfg. Co.*, wherein this Court, on November 19, 1941, sustained the Seventh Circuit in finding invalidity of claims that had been held valid in the Second Circuit. The attitude of the Seventh Circuit is strikingly reflected by its decision in the present case. Of the eight patents sued upon (six of which were considered by the Circuit Court of Appeals) only the present patent was sustained after the rigid tests of patentability applied by that Court.

Even if this Court should entertain doubt, notwithstanding-

ing two separate adjudications in two separate Circuits by four judges experienced in patent matters, all of whom concluded that Johnson had made a patentable invention, such doubt, if it can conceivably exist under these circumstances, should, under existing authorities, be resolved in favor of validity of the patent in suit.

This Court in *Hobbs v. Beach*, 180 U. S. 383, 389, said:

"* * * Of course, we are bound to give to this question of anticipation an independent consideration. At the same time, we feel ourselves bound to defer somewhat to this unanimity of opinion upon the part of so many learned and distinguished judges, whose lives have been largely devoted to the examination of patent causes."

In *Radio Corp. of America, et al. v. Radio Engineering Laboratories, Inc.*, 293 U. S. 1, 8, this Court said:

"* * * one otherwise an infringer who assails the validity of a patent fair upon its face bears a heavy burden of persuasion, and fails unless his evidence has more than a dubious preponderance. * * * If that is true where the assailant connects himself in some way with the title of the true inventor, it is so *a fortiori* where he is a stranger to the invention, without claim of title of his own."

2. No one skilled in the outboard motor art prior to Johnson conceived that an anti-cavitation plate and a housing streamlined above and below the plate would so co-operate as to produce a lower unit of an outboard motor which would permit a boat to be safely propelled at high speed.

3. The Petitioner does not avail itself of the prior art that it urges invalidates the Johnson patent and which it could use with immunity from suit, but regards the combined anti-cavitation plate and streamline housing, contributed to the art by Johnson, as so desirable that it must appropriate it even at the hazard of an infringement suit.

4. There has been an impressive showing in this case as to the importance and novelty of the invention. The evidence showed:

- a. The production and sale of sixty million dollars' worth of outboard motors embodying this invention (R. 250), the invention having been a prerequisite to the building of the high powered and high speed motors made under this license.
- b. Imitation of the invention by others, including the present Petitioner.
- c. Current respect of the patent by all builders of outboard motors other than the Petitioners.
- d. The patent has been sustained in two circuits (by Judge Knight, in a District Court in the Sixth Circuit, and by Judges Evans, Trainer and Briggle in the Seventh Circuit Court of Appeals).

The following statement of this Court in the *Diamond Rubber Co.* case, 220 U. S. 428, 441, is particularly pertinent to the case at bar:

"And yet the Rubber Company uses the Grant tire. It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation as others have done."

Public policy favors patent protection for meritorious inventions.

Even if there were doubt as to validity, public policy requires that a patent be sustained rather than destroyed.

The framers of the Constitution recognized the importance to the public of encouraging the making of inventions by conferring upon Congress the power:

"To promote the progress of science and useful arts, by securing for limited terms to authors and inventors the exclusive right to their respective writings and discoveries."

President Washington in his first annual address to Congress on January 8, 1790 said:

"I cannot forbear intimating to you the expediency of giving effectual encouragement as well to the introduction of new and useful inventions from abroad as to the exercise of skill and genius in producing them at home." (Messages and Papers of the Presidents, Vol. I, p. 66.)

President John Quincy Adams, in his first annual message to Congress on December 6, 1825, expressed apprehension lest the then existing laws did not insure to inventors an adequate reward. He said:

"If an honest pride might be indulged in the reflection that on the records of the (Patent) Office are already found inventions, the usefulness of which has scarcely been transcended in the annal of human endeavor, would not its exaltation be allayed by inquiry whether the laws have effectively insured to the inventors the reward destined to them by the Constitution—even a limited term of exclusive right to their disclosures." (Messages and Papers of the Presidents, Vol. II, p. 315.)

Mr. Chief Justice Marshall in *Grant v. Raymond*, 31 U. S. 217 (1832), stated (pp. 240, 242):

"To promote the progress of useful arts, is the interest and policy of every enlightened government. It entered into the views of the framers of our constitution, and the power 'to promote the progress of science and useful arts, by securing for limited times to authors and inventors, the exclusive right to their respective writings and discoveries,' is among those expressly given to congress. This subject was among the first which followed the organization of our government."

"It is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this

purpose ought, we think, to be construed in the spirit in which they have been made; and to execute the contract fairly on the part of the United States, where the full benefit has been actually received; if this can be done, without transcending the intention of the statute, or countenancing acts which are fraudulent, or may prove mischievous. The public yields nothing which it has not agreed to yield; it receives all which it has contracted to receive. The full benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved; and for his exclusive enjoyment of it, during that time, the public faith is pledged."

• • • The great object and intention of the act is, to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals, for the time and labor devoted to these discoveries, by the exclusive right to make, use and sell the things discovered, for a limited time."

President Pierce in his first annual message to Congress on December 5, 1853 said:

"I commend to your favorable consideration the men of genius of our country who by their inventions and discoveries in science and arts have contributed largely to the improvements of the age without, in many instances, securing for themselves anything like an adequate reward." (Messages and Papers of the Presidents, Vol. V, p. 217.)

President McKinley in a message to Congress on December 5, 1899 said:

"Our future progress and prosperity depend upon our ability to equal, if not surpass, other nations in the encouragement and advance of science, industry and commerce. To invention we must turn as one of the most powerful aids to the accomplishment of such results." (Messages and Papers of the Presidents, Vol. X, p. 163.)

That the framers of the Constitution, this Court and many of our Presidents correctly appraise the importance to the public of encouraging inventions, has been abundantly demonstrated. Inventions have opened large fields of industry, have greatly increased the productivity of agriculture, and have added immeasurably to the comforts, pleasure and convenience of the public. The importance of encouraging the making of such inventions amply justifies the patent system and its future preservation.

That the public has benefited far more than it has been injured by the granting of patents seems uncontrovertible. Unlike any monopoly based on financial power or arbitrary grant, Letters Patent for inventions are limited in duration and take nothing from the public which it already had, but merely secure to inventors seventeen years of exclusive right to that which they create.

In *United States v. United Shoe Machy. Co.*, 247 U. S. 32, 57, this Court said:

"Of course, there is restraint in a patent. Its strength is in the restraint, the right to exclude others from the use of the invention, absolutely or on the terms the patentee chooses to impose. This strength is the compensation which the law grants for the exercise of invention. * * *

"We must keep in mind the quality of the right we are considering and that the inventor gets nothing from the law that he did not have before and that the only effect of his patent is to restrain others from dealing with or using its device. *United States v. Bell Tel. Co.*, 167 U. S. 224, 239; *Paper Bag Patent Case*, 210 U. S. 405, 424; *Motion Picture Co. v. Universal Film Co.*, 243 U. S. 502, 510. Or to put it another way, the inventor does not get from the law a right to a use that he did not have before but he gets the right to an exclusive use. Take this from him and you take all that the law gives him and to secure which the public faith is pledged. Chief Justice Marshall in *Grant v. Raymond*, 6 Pet. 218, 242."

Again in *United States v. Dubilier Condenser Corp.*, 289 U. S. 178, 186, this Court said:

"Though often so characterized, a patent is not, accurately speaking, a monopoly, for it is not created by the executive authority at the expense and to the prejudice of all the community except the grantee of the patent. *Seymour v. Osborne*, 11 Wall, 516, 533. The term monopoly connotes the giving of an exclusive privilege for buying, selling, working, or using a thing which the public freely enjoyed prior to the grant. Thus a monopoly takes something from the people. An inventor deprives the public of nothing which it enjoyed before his discovery, but gives something of value to the community by adding to the sum of human knowledge."

Many patent cases come before this Court on account of diversity of decision regarding validity or infringement. Cases in which there have been concurring decisions sustaining the validity of a patent are not ordinarily reviewed by this Court.

The result of this situation has been that the patents reviewed by this Court are usually of doubtful validity, and consequently many have been held invalid, which seems to have led lower courts to form an incorrect conclusion in regard to the attitude of this Court. For example, the Court of Appeals for the Second Circuit stated in *Buono v. Yankee Maid Dress Corp.*, 77 F. (2d) 274, 276 (May 6, 1935):

"* * * We should indeed have no question, were it not for the high standard demanded for invention by the decisions of the Supreme Court in recent years. We cannot disregard this disposition and we must follow as faithfully as we can."

In the present case there is no conflict of decision. It is submitted that the patent is clearly valid, as held by decisions in both the Seventh and Sixth Circuits, and it is respectfully suggested that this Court, on the basis of a thoroughly meritorious case, again emphasize the impor-

tance of sustaining patents which have effected real advances and thereby encourage the making of inventions under the stimulus of the reward given by the exclusive rights granted by a patent.

CONCLUSION.

It is submitted that Petitioners have not overcome the *prima facie* validity of the Johnson patent, as the three points they rely upon are inadequate to prove invalidity beyond a reasonable doubt.

Point I. Petitioners' contentions with regard to invalidity of the claims by reason of alleged belated introduction are not supported either by the facts or the law.

a. Every premise asserted by Petitioners as a basis for its contention has been shown to be contrary to the record evidence. It is not a fact that the subject matter involved in this litigation was first claimed on March 30, 1929. It is not a fact that until 1929 every claim of the application for patent in suit was limited to the deflecting plate. It is not a fact that the drawing of the application for the patent in suit showed nothing which was not standard or conventional other than the arched extension of the housing and the deflecting plate carried thereby. It is not a fact that the subject matter of the claims in suit had been commercially adopted more than two years prior to the introduction of claims to such subject matter. It is not a fact that this issue was pleaded or considered or presented below. The briefs certified to this Court from the Circuit Court of Appeals demonstrate conclusively that the page upon which Petitioners assert this issue to have been raised is addressed to an entirely different proposition and fails even to suggest the issue which Petitioners seek thus belatedly to inject into this case without giving Respondents an opportunity to present their evidence thereon.

b. The cases cited by Petitioners likewise fail to support their position. They are all cases in which "new

matter" had been introduced into a patent and they are cases in which the rights of others had intervened. Petitioners have not only failed to show any new or inconsistent matter, or any matter undisclosed in the original drawings, but have failed to show any intervening rights in their behalf or in behalf of others. This is not a case where claims have been broadened in an effort to dominate some intervening contribution to the art. The claims in the present application cover only what was originally disclosed herein and no competitor, particularly not present Petitioners, has made any independent contribution which would be dominated by claims which seek only to cover the actual invention of Johnson. Even as to competitors who were using the identical combination of the claims in suit, these claims were introduced well within two years of the first competitive use. This is shown by record evidence completely refuting Petitioners' assertions to the contrary.

Point II. The defense of aggregation, expressly repudiated by the Court of Appeals "in the face of what is established by testimony and confirmed by our study" (R. 622) has not been sustained here. In fact Petitioners have tried to evade this issue by urging bald assertions and avoiding any discussion of the evidence. The uncontested testimony of practical expert witnesses establishes that there is cooperation between the elements of the claimed combinations to produce results wholly new to the art. The defense of aggregation is not sustained.

Point III. The defense of anticipation or want of invention which Petitioners seek to raise on their briefs, without having tendered any such issue by their petition, has not been accepted in the Seventh or Sixth Circuits. The patent covers a novel structure of great utility, as evidenced by sales to the extent of sixty million dollars worth of outboard motors of a speed and power made possible by the invention of the patent in suit. Petitioners' ap-

propriation of the invention of the patent in suit, in the face of this litigation, despite the fact that the prior art upon which they relied is available to them, is further evidence of the utility and importance of the invention. The acquiescence in the patent by the industry is further evidence.

Evidence of commercial acceptance is available to Respondents if the question of validity is in doubt. It would be absurd to say, in the present case, that invalidity is so free from doubt that evidence of commercial success would not be available, when four judges in two circuits have held the patent valid.

However, Respondents have not only relied upon a showing entitling them to the benefit of doubt of invalidity, but have gone farther and demonstrated conclusively that upon the facts established by the record in this case, the invention of the patent in suit solved a problem admitted by Petitioners themselves in their brief in this Court to be a problem of long standing, for which Petitioners have shown no prior art solution. No solution was even remotely suggested by the prior art despite every incentive to develop one. On the evidence, therefore, the claims in suit are such as to involve invention by any test.

It is submitted that the judgment of the Court of Appeals for the Seventh Circuit, holding valid claims 11, 12, 13 and 14 of Johnson patent No. 1,716,962, was correct, and should be affirmed.

Respectfully submitted,

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